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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/533,904 | 03/21/2000 | Auvo K. Kettunen | 10-1304 | 7934 |

23117 7590 11/13/2009

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| EXAMINER | |
|---|---|
| NGUYEN, TAN D | |
| ART UNIT | PAPER NUMBER |
| 3689 | |
| MAIL DATE | DELIVERY MODE |
| 11/13/2009 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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*Ex parte* AUVO K. KETTUNEN

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Appeal 2009-012735
Application 09/533,904 to reissue US Patent 5,779,856
Technology Center 3600

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Decided: November 12, 2009

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Before ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judge,*
BRADLEY R. GARRIS, *Administrative Patent Judge,* and
FRED E. MCKELVEY, *Senior Administrative Patent Judge.*

GARRIS, *Administrative Patent Judge.*

DECISION ON APPEAL

Applicant appeals under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 47-53. We have jurisdiction under 35 U.S.C. § 6.

We AFFIRM.

*Statement of the Case*

Appellant claims a method for producing pulp from fiber material. The method comprises providing an impregnation zone for impregnating the fiber material, providing a digester having first and second cooking zones for cooking the impregnated fiber material, supplying a first portion of the total amount of cooking liquor to the impregnation zone and the first cooking zone, obtaining a first effective alkali concentration in the first cooking zone, passing the fiber material and the cooking liquor through the first cooking zone, and supplying a second portion of the total amount of cooking liquor to the second cooking zone to obtain a second effective alkali concentration in the second cooking zone, the second alkali concentration being between about 15 grams/liter and about 50 grams/liter greater than the first effective alkali concentration.

Further details regarding this claimed method are set forth in representative independent claim 47 which reads as follows:

47. A method for producing pulp, comprising the steps of:

providing a fiber material, a transport liquid and an impregnation zone;

providing a digester to facilitate a cooking reaction, the digester having at least one screen girdle section disposed therein, the digester having a first cooking zone and a second cooking zone;

providing a total amount of cooking liquor required for the cooking reaction;

transporting the fiber material and the transport fluid to the impregnation zone;

heating and impregnating the fiber material disposed in the impregnation zone;

transferring the heated and impregnated fiber material from the impregnation zone to the first cooking zone;

supplying a first portion of the total amount of the cooking liquor to the impregnation zone and the first cooking zone;

obtaining a first effective alkali concentration in the first cooking zone;

passing the fiber material and the cooking liquor through the first cooking zone; and

supplying a second portion of the total amount of the cooking liquor to the second cooking zone to obtain a second effective alkali concentration in the second cooking zone, the second alkali concentration being between about 15 grams/liter and about 50 grams/liter greater than the first effective alkali concentration.

The Examiner rejects claims 47-53 under 35 U.S.C. § 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based.

The Examiner describes the rationale for this rejection as follows:

> In application 08/736,112, which matured into U.S. Patent 5,779,856, applicant amended claim 16 to include the limitation in step (e) that the spent second (2nd) cooking liquor possessed an effective alkali concentration of greater than about "20 g/l". Similarly, claim 16 was also amended to recite the limitation that during at least the last fifteen minutes of step (e), the effective alkali concentration is between "20-40 g/l, so as to produce chemical pulp having enhanced intrinsic fiber strength compared to if the effective alkali concentration was below 15 g/l during the last fifteen minutes of step (e)" [claim 16, step (f)]. Both of these

> amendments to claim 16 were made to overcome the rejections involving US Patent 5,522,958 to Li. See the amendment of November 12, 1997, page 10, first and second paragraphs. Newly added claim 47, however, does not include these limitations which applicant presented in application 08/736,112 to overcome the prior art of record. Thus, applicant is attempting to recapture subject matter which was surrendered in application 08/736,112.

(15 July 2002 Ans. 3; *see also* 31 March 2009 Supp. Ans. 3-4).

Concerning this rejection, Appellant states that "[c]laims 47-53 may be grouped and thus considered to stand or fall together" (29 April 2002 App. Br. 3). Therefore, in assessing the propriety of the rejection, we will focus on claim 47 which is the sole independent claim on appeal.

*Issue*

Has Appellant shown error in the Examiner's determination that reissue claim 47 is an attempt to recapture subject matter surrendered in an effort to obtain allowance of the original patent claims?

*Findings of Fact*

As indicated above, the Examiner finds that limitations in steps (e) and (f) of patent claim 16 were added in a successful effort to obtain allowance of the claim and that reissue claim 47 does not include these limitations.

On this record, Appellant does not dispute these findings by the Examiner.

*Principles of Law*

Under the recapture rule, a patentee is precluded from regaining or recapturing subject matter that had been surrendered in an effort to obtain

allowance of the original claims. *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335, 1349 (Fed. Cir. 2005).

As explained in *North American Container*:

> We apply the recapture rule as a three-step process: (1) first, we determine whether, and in what respect, the reissue claims are broader in scope than the original patent claims; (2) next, we determine whether the broader aspects of the reissue claims relate to subject matter surrendered in the original prosecution; and (3) finally, we determine whether the reissue claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid the recapture rule.

(*Id.*).

> [T]his principle [i.e., avoidance of the recapture rule], in appropriate cases, may operate to overcome the recapture rule when the reissue claims are materially narrower in other overlooked aspects of the invention. The purpose of the exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects.

*Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 1482-83 (Fed. Cir. 1998).

*Analysis and Conclusions of Law*

Concerning step (1) of the recapture rule analysis, as pointed out earlier, Appellant does not dispute the Examiner's finding that reissue claim 47 is broader in scope than original patent claim 16 in the aspects that the reissue claim does not include limitations in steps (e) and (f) of the patent claim.

Regarding step (2) of the analysis, the Examiner finds that these broader aspects of reissue claim 47 relate to subject matter surrendered in

prosecution of the original patent application (Ans. 3). As support for this finding, the Examiner relies on the first two paragraphs at page 10 of the amendment filed 12 November 1997 (*id.*). Appellant does not specifically contest this finding or the evidence in support thereof. Instead, Appellant argues that the Examiner's finding is "not pertinent" (29 April 2002 App. Br. 4).

In this regard, Appellant presents the following contention:

> [A]pplicant notes that the limitation of step (e) in claim 16 of the original '856 patent relates to the effective alkali (EA) concentration of the *spent* cooking liquor from the *second cook zone*. Applicant suggests that the EA concentrations referenced by the Examiner to support this rejection are not pertinent at all to the subject matter claimed by new claim 47. Specifically, claim 47 and claims 48-53 dependent thereon do not address the EA concentration of any *spent* cooking liquors. Instead, independent claim 47 recites the difference in the EA concentration between the *cooking* liquors *at the beginning of the first and second cooking zones*. As such, the recitation of the difference in such EA concentration is not recapturing at all any subject matter that was cancelled from the original '856 patent.

(*Id.*)

Appellant presents similar contentions in the Reply Briefs (16 September 2002 Reply Br. 1-2; 27 May 2009 Reply Br. 3-4).

There is no merit in Appellant's contention that the Examiner's finding regarding analytical step (2) is not pertinent. This finding is directly responsive to the step (2) question of whether the broader aspects of reissue claim 47 relate to subject matter surrendered in the original prosecution. On the other hand, we do not see and Appellant does not explain why the asserted difference between the cooking liquors of patent claim 16 and of

reissue claim 47 is relevant to the established 3-step process for analyzing the recapture rule.

The third step of the recapture analysis relates to whether the reissue claims were materially narrowed in other respects, so that the reissue claims may not have been enlarged, and hence avoid the recapture rule. Although Appellant does not explicitly refer to step (3) of the analysis, Appellant's following comments seem germane to this step:

> [T]he reissue claims at issue, while broader in some respects, are also narrower in other respects. For example, applicants [sic] note the claims at issue here are narrower with respect to the requirement that a step of impregnation of the fiber material must occur that [sic, and] that it is the digester which has first and second cooking zones having the stated EA concentrations. And, as noted above, the EA concentration as expressed in the present claim 47 is also actually narrower with respect to the minimum limitation of 20 g/l expressed in step (e) of original '856 patent claim 16.

(29 April 2002 App. Br. 5).

For a number of reasons, these comments do not establish that claim 47 avoids the recapture rule. First, Appellant has not specifically identified the limitations actually recited in claim 47 that are considered to be narrower than the original patent claims. Second, Appellant has not explained why such reissue claim limitations are considered to be "materially narrowed in other respects, so that the claims may not have been enlarged, and hence avoid the recapture rule" (*North American Container*, 415 F.3d at 1349). For example, Appellant fails to even assert much less establish that "the reissue claims are materially narrower in other overlooked aspects of the invention" (*Hester Industries*, 142 F.3d at 1482-83; emphasis added).

For the above-stated reasons, Appellant has not shown error in the Examiner's determination that reissue claim 47 is an attempt to recapture subject matter surrendered in an effort to obtain allowance of the original patent claims.

Therefore, we sustain the Examiner's § 251 rejection of all appealed claims based on recapture.

*Order*

The decision of the Examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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